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EXAMINER

FISCHMANN, BRYAN R

ART UNIT PAPER NUMBER

3618

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,457

Applicant(s)

NODA, TOMOHIDE

Examiner

Bryan Fischmann

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ST

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/120,415.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-25-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Divisional Application

1. This Application is a divisional application of Application number 10/120,415 under 37 CFR 1.53(b), as noted on the transmittal dated 12-03-2003.

Specification

2. The disclosure is objected to because of the following:

A) The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Note that paragraph 0067 incorporates a foreign patent by reference.

B) Line 4 of paragraph 0019 is considered to be awkwardly worded.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

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The drawings are considered informal as some "captions" in the drawings, such as "Vehicle Rearward Side" are not uniform and well defined.

4. Figures 7 and 8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance:

5. The structure corresponding to reference number 48 on Figure 1 (right side only) is objected to, as the "convexity", reference number 48 on the right side of Figure 1 appears to be "oriented" such that it is substantially parallel to the plane of the insertion member 40 that includes the opening 44.

Claim Objections

6. Claims 1 and 2 are objected to because of the following:

A) Claim 1 recites "...wherein the webbing guide is disposed in or near the opening".

As noted in this Office Action, this Application is a divisional application. Though not necessarily an "explicit requirement" after reviewing Section 201.16 of the MPEP,

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divisional applications generally set forth claims that are drawn to a non-elected species or invention of the parent patent.

In the prosecution of parent application 10/120,415, a species election was made between Species I, (Figures 1-3) and Species II (Figure 4). Applicant elected to prosecute Species I in the parent application.

Due to this, it is best understood that Applicant is intending to prosecute Species II, only, of the parent application in the Instant Application. This seems consistent with the limitations of claims 1-6 with the exception, of a portion of claim 1 recited above.

However, note that the words "or near the opening" in the above claim 1 recitation seems to imply that the webbing guide could include the "convexity" set forth in Species I.

If it is Applicant's intent that claim 1 is "generic" to Species I and II (Figures 1-4) of the parent Application, then prosecution of this Instant Application may include a species election and/or double patenting in future actions.

B) Claim 2 recites "the longitudinal direction". Note that it is not considered obvious which direction is the "longitudinal direction", as the "shape" of the opening has not been defined in claims 1 or 2.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando, et al, US Patent 4,480,853.

Ando teaches an insertion member (10) for a vehicle seat belt webbing (12) comprising:

- a hole (Figure 3) for pivotally connecting (arrow A) the member to the vehicle;
- an opening (50) in the member through which the webbing passes;
- a bearing surface over which the webbing slides during retraction and extraction (portion of 43 directly under the webbing);

wherein the length of the opening is slightly greater than the width of the webbing (Figure 2) so that as the webbing passes through the opening ends of the opening confront left and right sides of the webbing in order to substantially prevent the webbing from shifting laterally within the opening (see comments below).

Regarding the claim 1 limitation "wherein the webbing guide is disposed in or near the opening", note that "in" is selected in the above recitation and the "webbing guide" is the "ends" of opening 50. This also applies to claim 4.

Regarding claims 2 and 6, see Figure 2.

Regarding the claim 5 limitation "so that as the webbing passes through the opening ends of the opening confront left and right sides of the webbing in order to substantially prevent the webbing from shifting laterally within the opening", it is noted this limitation is drawn toward "intended use" of the claimed invention. The functional

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recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the function or intended use, then it meets the claim. *In re Casey*, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967). It is the Examiner's position that the prior art is capable of performing the intended use.

Once this prima facie case has been established, the burden shifts to the applicant to show that the prior art structure does not possess the functionally defined or intended use limitations of his claimed apparatus. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ando, et al, US Patent 4,480,853.

Claim 3 recites "...wherein the length of the opening in the longitudinal direction is 1.01 to 1.1 times as large as the width of the webbing". This limitation would appear to be taught by Figure 2 of Ando, though a specific length of the opening in a longitudinal direction and a specific width of the webbing is not explicitly stated by Ando.

However, note that it is considered within the skill level of one of ordinary skill in the art to optimize a range based on prior art general conditions. See Section 2144.04 of the MPEP. Manufacturing the webbing insertion member such that the length of the opening in a longitudinal direction is 1.01 to 1.1 times as large as the width of the webbing is advantageous in that if the length of the opening were 1.00, or less, the webbing would likely tend to bind in the opening. If the length were greater than 1.1 times as large as the width of the opening, the webbing would tend to "meander" back and forth along the length of the opening, possibly impeding the movement of the webbing relative to the opening, or "retraction" or "extraction" of the webbing of the belt.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilizing an opening in an insertion member that has a length that is 1.01 to 1.1 times as large as the width of the webbing.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fohl (2 patents), Higbee, Moringa, et al, Grau, FR 278387 and EP 307339 – teach webbing insertion members with openings for webbing to pass through

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12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 9:00 to 5:30.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRYAN FISCHMANN
PRIMARY EXAMINER